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EXAMINER				
TOPGYAL, GELEK W				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
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Office Action Summary

Application No.

10/661,489

Applicant(s)

OGAWA ET AL.

Examiner

GELEK TOPGYAL

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/18/2010 have been fully considered but they are not persuasive.
2. In re pages 12-13, the applicants present the sole argument that Nagasaka fails to teach the new limitation of "a plurality of static image data and each static image data represents scenes in the video data having variable time width for the portion of video data represented in the scene". It is argued that Fig. 7 of Nagasaka merely collects a variable number of shot-representative pictures, and not a collection of pictures representing portions of video having variable time widths.
3. In response, the examiner respectfully disagrees. Col. 9, line 8 through Col. 10, line 67 discusses the digest making process wherein the shot-representative pictures are extracted when a new scene/shot is determined. Figure 7 displays a result of such wherein over several 15 minute intervals between 11:00 and 12:00, various different numbers of shot-representative pictures have been extracted, e.g., between 11:00 and 11:15, 4 shot-representative pictures have been extracted. Similarly, within the next three 15 minute intervals a different number of 2, 7 and 3 shot-representative pictures have been extracted. The created digest includes a different number of shot-representative pictures over a 15 minute interval. Col. 8, lines 19-36 teaches wherein the shot-representative pictures are used to display a digest, from which, upon selection of a shot-representative pictures by a user, reproduction from the position where the shot-representative picture was created is commenced. The shot-representative

pictures displayed represent the scenes in the video data with varying time widths since for similar 15 minute intervals there exists varying number of shot-representative pictures. Additionally, as admitted to by the applicants, the shot-representative pictures are not created on a fixed interval. Therefore, the shot-representative pictures, when presented as a digest for reproduction, represent the scenes in the video data with variable time widths. For further discussion, e.g., a first 15 minute interval has two shot-representative pictures and a second 15 minute interval has seven shot-representative pictures. Therefore, in the first 15 minute interval, the two shot-representative pictures (first group) can represent two scenes (whose width varies with the shot detection). Similarly, in the second 15 minute interval, the seven shot-representative pictures (second group) can represent seven scenes (whose width varies with the shot detection). Therefore, it is at least clear that the first group of shot-representative pictures represent scenes in the video data having varying widths that are at least larger than compared to the second group of shot-representative pictures.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Claims that recite nothing but the physical characteristics of a form or energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are

nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of four statutory classes of 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 5-8 and 16-19 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent and recent Federal Circuit decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, an image reduction process comprising (1) extracting, obtaining, and reproducing steps, (2) extracting, obtaining, requesting and reproducing steps, or (3) extracting, associating, accepting and reproducing steps is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Furthermore, claims 9-12, 20, 28-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Regarding claims 9-12, 20, 28-31, in the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a "data storage medium" covers a signal per se. Therefore, it is suggested by the examiner that

the applicants amend the claims to additionally recite that the data storage medium is of a "non-transitory" type.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders et al. (US 2006/0288113) in view of Nagasaka (US 5,974,218).

Regarding claim 1, Saunders et al. teaches an image reproduction system that reproduces static image data synchronously with reproduction of video data, comprising:

a position information obtainment unit that obtains a reproduction time position of the video data as the video data is reproduced (Paragraph 42 teaches wherein a content author can determine the rendering time for a video component of the entire presentation. Fig. 5 further shows where Video 502 is synchronized along with other media samples/data. Paragraph 44 teaches that rendering times for each video sequences 714 are stored by the format writer 716 as part of the presentation. Paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and reproduces according to the rendering times set in the presentation);

an image obtainment unit that obtains extracted static image data associated in advance with the obtained reproduction time position (Paragraph 42 teaches wherein a content author can determine the rendering time for each media sample ("HTML, image") of the entire presentation. Fig. 5 further shows where media samples within Banner 504, Slides 506 are synchronized along with other media samples/data. Paragraph 44 teaches that rendering times for media samples are stored by the format writer 716 as part of the presentation. Paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and reproduces according to the rendering times set in the presentation); and

an image reproduction unit that reproduces the obtained static image data synchronously with the video data (Fig. 5 and Paragraphs 51-53 teaches where a client access a presentation which is reproduced according to the rendering times set by the user as discussed above).

However, Saunders fails to particularly teach a preprocessing unit that extracts static image from the video data by an operator operation that performs the setting operation while viewing the data before a disposition registration of the video data is initiated, wherein the preprocessing unit extracts a plurality of still image data and each static image data represents scenes in the video data having variable time width for the portion of video data represented in the scene;

In an analogous art, Nagasaka et al. teaches in col. 3, lines 43-48, col.3, line 56 through col. 4, line 35, col. 9, line 9 through col. 10, line 67 wherein a broadcast program is programmed to be recorded by a user. During the recording of the broadcast

program a digest picture is extracted from the video program. The extraction of shot-representative pictures are extracted based on a detection of a new scene/shot. The scene/shot length can vary from one scene to the next according to the broadcast program and hence the extraction of the static image (generation of shot-representative pictures) is based on a variable time-width. Furthermore, col. 8, lines 19-36 teaches wherein the shot-representative pictures are used to display a digest, from which, upon selection of a shot-representative pictures by a user, reproduction from the position where the shot-representative picture was created is commenced. The shot-representative pictures displayed represent the scenes in the video data with varying time widths since for similar 15 minute intervals there exists varying number of shot-representative pictures. Additionally, the shot-representative pictures are not created on a fixed interval. Therefore, the shot-representative pictures, when presented as a digest for reproduction, represent the scenes in the video data with variable time widths. For further discussion, e.g., a first 15 minute interval has two shot-representative pictures and a second 15 minute interval has seven shot-representative pictures. Therefore, in the first 15 minute interval, the two shot-representative pictures (first group) can represent two scenes (whose width varies with the shot detection). Similarly, in the second 15 minute interval, the seven shot-representative pictures (second group) can represent seven scenes (whose width varies with the shot detection). Therefore, it is at least clear that the first group of shot-representative pictures represent scenes in the video data having varying widths that are at least larger than compared to the second group of shot-representative pictures.

The system of Saunders et al. can be modified to allow for capturing and storing of the still image files, as taught by Nagasaka so that the extracted still images can be used for the media presentation file of Saunders et al. Thereafter, the still images of Nagasaka can be added to the existing presentation to finalize a presentation as desired. The still images are extracted even before the corresponding broadcast program has completed recording, therefore, the system of Saunders et al. can not utilize the extracted digest pictures or the associated video. Therefore, the extraction of the digest picture occurs before a disposition registration can even begin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to extract a still image from a video data stream as taught by Nagasaka into the system taught by Saunders et al., because such incorporation would allow a user in Saunders et al. to seize or grasp the content and composition of a video speedily (Nagasaka in col. 3, lines 27-31).

Regarding claim 2, Saunders et al. teaches an image reproduction system that reproduces static image data synchronously with reproduction of video data, comprising:

a delivery server that holds the video data and static image data associated with the video data (Paragraph 0042 teaches of at least "video component stream 502" and "slides component stream 508" (still images) are "delivered from the media server to the client in a synchronous manner to form a complete presentation". Additionally, paragraph 0042 teaches "a content author obtains or creates web content data and/or media data such as ... (e.g. HTML, image), audio and/or video represented by arrow

704, which is used to create a presentation file/stream. Paragraph 49 teaches that "the media server 742 may receive the presentation stream 744 or the presentation file 746". Since the presentation file 746 is created using the at least "video component stream 502" and "slides component stream 508", the media server holds the video and static image data associated with the video data); and

a browsing client that reproduces and displays on a screen the video data and static image data provided by the delivery server (paragraphs 51-53, client browses a presentation "after receiving the playback request from the client, the media server 742 delivers the presentation stream 744 or presentation file 746 to the client" (first line of paragraph 0051). The rendering in Saunders means is rendered for display (paragraph 0031: "Rendering 1 sample may trigger the rendering or display of these media samples altogether") on browser 758 or the multimedia player 760. The display on the client device is taught in paragraph 0072, wherein "In operation, a client uses a computer such as a In addition, the format reader 764 executes instructions to retrieve an audio component stream 102, a video component stream 104, and a script component stream 108 from the presentation stream 754 or presentation file 756 and to deliver these component streams to a browser 758 or multimedia player 760."),

wherein the browsing client comprises:

a position information obtainment unit that obtains a reproduction time position of the video data as the video data is reproduced (paragraphs 54-57 teaches a renderer that uses a browser 758 or a multimedia player 760 that receives the presentation and

reproduces according to the rendering times set in the presentation (as discussed in claim 1 above));

an image request unit that makes a request to the delivery server for the static image data associated in advance with the reproduction time position (paragraphs 51-53 teaches where a user on a client machine requests a particular presentation to be accessed/viewed. The presentation includes the still images within media samples); and

an image reproduction unit that reproduces the static image data synchronously with the video data, the static image data being provided by the delivery server in response to the request (paragraphs 56-57 teaches where a presentation, which includes video 502 and images stored by itself or within Banners 504 and/or Slides 506 are reproduced in synchronism).

However, Saunders fails to particularly teach a preprocessing unit that extracts static image from the video data by an operator operation that performs the setting operation while viewing the data before a disposition registration of the video data is initiated, wherein the preprocessing unit extracts a plurality of still image data and each static image data represents scenes in the video data having variable time width for the portion of video data represented in the scene;

In an analogous art, Nagasaka et al. teaches in col. 3, lines 43-48, col.3, line 56 through col. 4, line 35, col. 9, line 9 through col. 10, line 67 wherein a broadcast program is programmed to be recorded by a user. During the recording of the broadcast program a digest picture is extracted from the video program. The extraction of shot-

representative pictures are extracted based on a detection of a new scene/shot. The scene/shot length can vary from one scene to the next according to the broadcast program and hence the extraction of the static image (generation of shot-representative pictures) is based on a variable time-width. Furthermore, col. 8, lines 19-36 teaches wherein the shot-representative pictures are used to display a digest, from which, upon selection of a shot-representative pictures by a user, reproduction from the position where the shot-representative picture was created is commenced. The shot-representative pictures displayed represent the scenes in the video data with varying time widths since for similar 15 minute intervals there exists varying number of shot-representative pictures. Additionally, the shot-representative pictures are not created on a fixed interval. Therefore, the shot-representative pictures, when presented as a digest for reproduction, represent the scenes in the video data with variable time widths. For further discussion, e.g., a first 15 minute interval has two shot-representative pictures and a second 15 minute interval has seven shot-representative pictures. Therefore, in the first 15 minute interval, the two shot-representative pictures (first group) can represent two scenes (whose width varies with the shot detection). Similarly, in the second 15 minute interval, the seven shot-representative pictures (second group) can represent seven scenes (whose width varies with the shot detection). Therefore, it is at least clear that the first group of shot-representative pictures represent scenes in the video data having varying widths that are at least larger than compared to the second group of shot-representative pictures.

The system of Saunders et al. can be modified to allow for capturing and storing of the still image files, as taught by Nagasaka so that the extracted still images can be used for the media presentation file of Saunders et al. Thereafter, the still images of Nagasaka can be added to the existing presentation to finalize a presentation as desired. The still images are extracted even before the corresponding broadcast program has completed recording, therefore, the system of Saunders et al. can not utilize the extracted digest pictures or the associated video. Therefore, the extraction of the digest picture occurs before a disposition registration can even begin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to extract a still image from a video data stream as taught by Nagasaka into the system taught by Saunders et al., because such incorporation would allow a user in Saunders et al. to seize or grasp the content and composition of a video speedily (Nagasaka in col. 3, lines 27-31).

Regarding claim 3, the proposed combination of Saunders et al. and Nagasaka teaches the claimed as discussed above in claim 1, and furthermore, Saunders et al. teaches the claimed further comprising:

a specification unit that accepts reproduction time position information of the video data from a user's input (as discussed in claim 1 above, wherein a content author can set rendering times for video sequences 502, 714, and the plethora of media samples including still images); and

a video reproduction unit that reproduces the video data from a time position corresponding to the accepted reproduction time position information (as discussed in claim 1 above),

wherein the position information obtainment unit obtains time position information specified by the user's input (as discussed in claim 1 above, wherein a content author can set rendering times for video sequences 502, 714, and the plethora of media samples including still images).

Regarding claim 4, Saunders et al. teaches an image reproduction system that reproduces video data and plural pieces of static image data in association with each other, comprising:

a specification unit that accepts a command provided by a user's input to select one piece of static image data from the plural pieces of static image data; (paragraphs 36-37 teaches wherein a client requests to seek to a particular point in the presentation. The client has the ability to seek to a particular point, including the locations of still images stored in banner 504 and/or slides 506); and

a video reproduction unit that reproduces the video data from a reproduction time position with which the selected piece of static image data is associated (as discussed above, after the client has chosen a particular still image, i.e. a particular location, the presentation resumes from that particular location).

However, Saunders fails to particularly teach a preprocessing unit that extracts static image from the video data by an operator operation that performs the setting

operation while viewing the data before a disposition registration of the video data is initiated, wherein the preprocessing unit extracts a plurality of still image data and each static image data represents scenes in the video data having variable time width for the portion of video data represented in the scene;

In an analogous art, Nagasaka et al. teaches in col. 3, lines 43-48, col.3, line 56 through col. 4, line 35, col. 9, line 9 through col. 10, line 67 wherein a broadcast program is programmed to be recorded by a user. During the recording of the broadcast program a digest picture is extracted from the video program. The extraction of shot-representative pictures are extracted based on a detection of a new scene/shot. The scene/shot length can vary from one scene to the next according to the broadcast program and hence the extraction of the static image (generation of shot-representative pictures) is based on a variable time-width. Furthermore, col. 8, lines 19-36 teaches wherein the shot-representative pictures are used to display a digest, from which, upon selection of a shot-representative pictures by a user, reproduction from the position where the shot-representative picture was created is commenced. The shot-representative pictures displayed represent the scenes in the video data with varying time widths since for similar 15 minute intervals there exists varying number of shot-representative pictures. Additionally, the shot-representative pictures are not created on a fixed interval. Therefore, the shot-representative pictures, when presented as a digest for reproduction, represent the scenes in the video data with variable time widths. For further discussion, e.g., a first 15 minute interval has two shot-representative pictures and a second 15 minute interval has seven shot-representative pictures. Therefore, in

the first 15 minute interval, the two shot-representative pictures (first group) can represent two scenes (whose width varies with the shot detection). Similarly, in the second 15 minute interval, the seven shot-representative pictures (second group) can represent seven scenes (whose width varies with the shot detection). Therefore, it is at least clear that the first group of shot-representative pictures represent scenes in the video data having varying widths that are at least larger than compared to the second group of shot-representative pictures.

The system of Saunders et al. can be modified to allow for capturing and storing of the still image files, as taught by Nagasaka so that the extracted still images can be used for the media presentation file of Saunders et al. Thereafter, the still images of Nagasaka can be added to the existing presentation to finalize a presentation as desired. The still images are extracted even before the corresponding broadcast program has completed recording, therefore, the system of Saunders et al. can not utilize the extracted digest pictures or the associated video. Therefore, the extraction of the digest picture occurs before a disposition registration can even begin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to extract a still image from a video data stream as taught by Nagasaka into the system taught by Saunders et al., because such incorporation would allow a user in Saunders et al. to seize or grasp the content and composition of a video speedily (Nagasaka in col. 3, lines 27-31).

Method claims 5-7 and medium claims 9-11 are rejected for the same reasons as discussed in claim 2 above. The limitations in claims 5-7 and 9-11 are broader than the limitations in claim 2.

Method claims 8 and medium claim 12 are rejected for the same reasons as discussed in claim 4 above. The limitations in claims 8 and 12 are broader than the limitations in claim 4 above.

Regarding claims 13-20, the proposed combination of Saunders et al. and Nagasaka teaches the claimed as discussed in claims 1-2 and 4-12 above, and furthermore, Saunders et al. teaches the claimed further comprising a retrieval interface (Fig. 7B and paragraph 49 teaches of a Client Site that retrieves a particular Presentation File) including a keyword input part that matches keyword input with contents data associated with the image data to retrieve results (Fig. 7B and paragraph 49 teaches of a Client Site that retrieves a particular Presentation File. In order to request a particular Presentation File, information to differentiate one Presentation File from another is inherently input by the user. See paragraph 3 above for further discussion).

Regarding claims 21-31, the limitations are met since the broadcast program recorded in Nagasaka consists of a plurality of frames. Col. 3, lines 43-48, col.3, line 56 through col. 4, line 35, col. 9, line 9 through col. 10, line 67, wherein col. 4, line 4 teaches "a detecting unit for *fetching the frame based picture signal* and for detecting or representative pictures those *frames which correspond to the inter-shot transitions of the television program*, respectively, a storage unit for storing the *digest picture*

constituted by a set of the representative pictures" The frame that is detected and later used for creating the *digest picture* is a single frame (therefore static) meets the static image data. Furthermore, the static images of materials used in a presentation shown in the video data is met by the *"frame which correspond to the inter-shot transition of the television program"* above.

It would have obvious to one of ordinary skill in the art at the time of the invention to combine the limitation of claims 21-31 as taught by Nagasaka with the teachings of Saunders et al. for the same motivation as discussed in claims 1-12 above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/
Examiner, Art Unit 2621

/Peter-Anthony Pappas/
Supervisory Patent Examiner, Art Unit 2621